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09/631,540	08/03/2000	Ryoichi Imanaka	MAT-3720US2	9344

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EXAMINER	
PARRY, CHRISTOPHER L	
ART UNIT	PAPER NUMBER
2421	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/631,540	IMANAKA, RYOICHI	
	Examiner	Art Unit	
	CHRIS PARRY	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 14-24 is withdrawn in view of the newly discovered reference(s) to Horton in view of Yoo. Rejections based on the newly cited reference(s) follow.

Response to Arguments

2. Applicant's arguments with respect to claims 14-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15, 17, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 15, 17, and 23 recite "wherein said information receiver determines whether said identifier is an approved identifier" however the specification does not provide support for an approved identifier to effect recording.

Examiner respectfully points out that the specification states (see Col. 8, lines 15-25), "the descramble apparatus certifies whether the medium in which the information was written has an approved ID number and only reading from the medium certified by the descramble apparatus, the descramble apparatus performs normally", emphasis added. Thus the cited portion of the specification is directed to determining the status of a medium after information has been recorded to the instant medium, and does not teach a step directed to conditionally recording on the medium, as a result of the detected status of an approved ID, as recited in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 14, 16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton et al. “Horton” (USPN 4,945,563) in view of Yoo (USPN 5,497,240).

Regarding Claim 14, Horton discloses an information receiver (20 - figure 1) for at least one of receiving information (i.e., television program received via a signal along

cable 22 from satellite dish 24) and recording said information on a recording medium (i.e., user may choose to tape a received program on VCR 44) (Col. 3, lines 31-47),

said information charged differently depending upon whether or not said information is recorded on said recording medium information (i.e., the subscriber pays a first fee to view a program and pays a second higher fee in order to view and record the program) (Col. 2, lines 59-65 and Col. 3, lines 39-60).

Horton fails to specifically disclose said recording medium evaluated to determine whether said recording medium includes an identifier prior to permitting recording of said information on said recording medium.

In an analogous art, Yoo discloses said recording medium evaluated to determine whether said recording medium includes an identifier prior to permitting recording of said information on said recording medium (i.e., before recording of a desired program can begin, microcomputer 90 must first detect the presence of tape ID code on the recording medium in order to facilitate properly indexing the recording medium) (figure 2; Col. 4, lines 27-52 and Col. 5, lines 1-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horton to include said recording medium evaluated to determine whether said recording medium includes an identifier prior to permitting recording of said information on said recording medium as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

Regarding Claim 16, Horton discloses an information receiver (20 - figure 1) for at least one of receiving information (i.e., television program received via a signal along cable 22 from satellite dish 24) and recording said information on a recording medium (i.e., user may choose to tape a received program on VCR 44) (Col. 3, lines 31-47), comprising:

receiving means for receiving information (i.e., receiver 20 receives a signal along cable 22 from a satellite dish 24) (Col. 3, lines 31-39);

recording means (44 – figure 1) for recording at least a portion of the information onto a recording medium (i.e., video cassette tape to be used by special VCR 44; Col. 4, lines 1-19 and Col. 2, lines 30-52), said information charged differently depending upon whether or not said information is recorded on said recording medium (i.e., the subscriber pays a first fee to view a program and pays a second higher fee in order to view and record the program) (Col. 2, lines 59-65 and Col. 3, lines 39-60).

Horton fails to specifically disclose verification means for verifying that the recording medium includes an identifier prior to permit recording of said information on said recording medium.

In an analogous art, Yoo discloses verification means (microcomputer 90 – figure 1) for verifying that the recording medium includes an identifier (i.e., tape ID code) prior to permit recording of said information on said recording medium (i.e., before recording of a desired program can begin, microcomputer 90 must first detect the presence of

tape ID code on the recording medium in order to facilitate properly indexing the recording medium) (figure 2; Col. 4, lines 27-52 and Col. 5, lines 1-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horton to include verification means for verifying that the recording medium includes an identifier prior to permit recording of said information on said recording medium as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

As for Claims 18 and 19, Horton and Yoo disclose, in particular Horton teaches determination means for determining whether the information should be provided to the recording medium (i.e., depending on the viewing mode selected by the user, the TV program will be correspondingly routed) (Col. 3, lines 43-53).

As for Claims 20 and 21, Horton and Yoo disclose, in particular Horton teaches notification means (46 – figure 1) for notifying the determination made by said determination means to a transmitter transmitting the information (Col. 3, lines 53-60).

Regarding Claim 22, Horton discloses a method of charging information (Col. 3, lines 31-60), said method comprising the steps of:

receiving information in an information receiver (i.e., receiver 20 receives a signal along cable 22 from a satellite dish 24) (Col. 3, lines 31-39);

recording the information onto a recording medium (i.e., user selects mode corresponding to view and record) (Col. 3, lines 43-56); and

charging a different amount based on whether or not the information is recorded on the recording medium (i.e., the subscriber pays a first fee to view a program and pays a second higher fee in order to view and record the program) (Col. 2, lines 59-65 and Col. 3, lines 39-60).

Horton fails to specifically disclose recording the information onto a recording medium if the recording medium includes an identifier (ID).

In an analogous art, Yoo discloses recording the information onto a recording medium if the recording medium includes an identifier (ID) (i.e., a subscriber video library system that detects the identity of a recording medium before recording, in order to determine whether a new or old tape has been inserted) (figure 2; Col. 4, lines 27-47 and Col. 5, lines 1-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horton to include recording the information onto a recording medium if the recording medium includes an identifier (ID) as taught by Yoo for the benefit of ensuring that the tape is properly indexed according the method being used by the recording system, (i.e., the video library system as disclosed by Yoo, Col. 2, lines 21-62).

7. Claims 15, 17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton in view of Yoo as applied to claims 14, 16, and 22 above, and further in view of Yarbrough et al. “Yarbrough” (USPN 4,598,288).

As for Claims 15, 17, and 23, Horton and Yoo fail to specifically disclose an wherein said information receiver determines whether said identifier is an approved identifier.

In an analogous art, Yarbrough discloses wherein said information receiver determines whether said identifier is an approved identifier (i.e., if the receiver system detects that a downloaded transmission is copyrighted or otherwise privileged, that the microprocessor 15 will confirm that there is an order for the instant broadcast program stored in RAM 13, before the broadcast program can be recorded) (Col. 5, lines 28-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horton and Yoo to include wherein said information receiver determines whether said identifier is an approved identifier as taught by Yarbrough for the benefit of combining prior art elements according to known methods to yield predictable results of facilitating preventing unauthorized access to the broadcast program (Yarbrough: Col. 2, lines 9-50).

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton in view of Yoo as applied to claim 14 above, and further in view of Garfinkle (USPN 5,400,402).

As for Claim 24, Horton and Yoo fail to specifically disclose an information receiver further comprising a timer and a storage device for storing said information.

In an analogous art, Garfinkle discloses an information receiver (10 – figure 2) according to claim 14, said information receiver further comprising:

a timer (38 – figure 2) for indicating a time period (Col. 4, lines 4-10 and lines 30-40); and

a storage device (20 – figure 2) in which said information is located (Col. 3, lines 12-26 and Col. 4, lines 25-29),

wherein upon expiration of said time period, availability of said information in said storage device is impaired (i.e., when the time period expires, the microprocessor issues a command to controller 44 to erase the video data stored in memory 20) (Col. 4, lines 30-48).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Horton and Yoo to include a timer, a storage device, wherein upon expiration of said time period, availability of said information in said storage device is impaired as taught by Garfinkle for the benefit of providing an inexpensive system to limit the use of a program stored at a customer site (Garfinkle: Col. 2, lines 15-18).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

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